

**REMARKS**

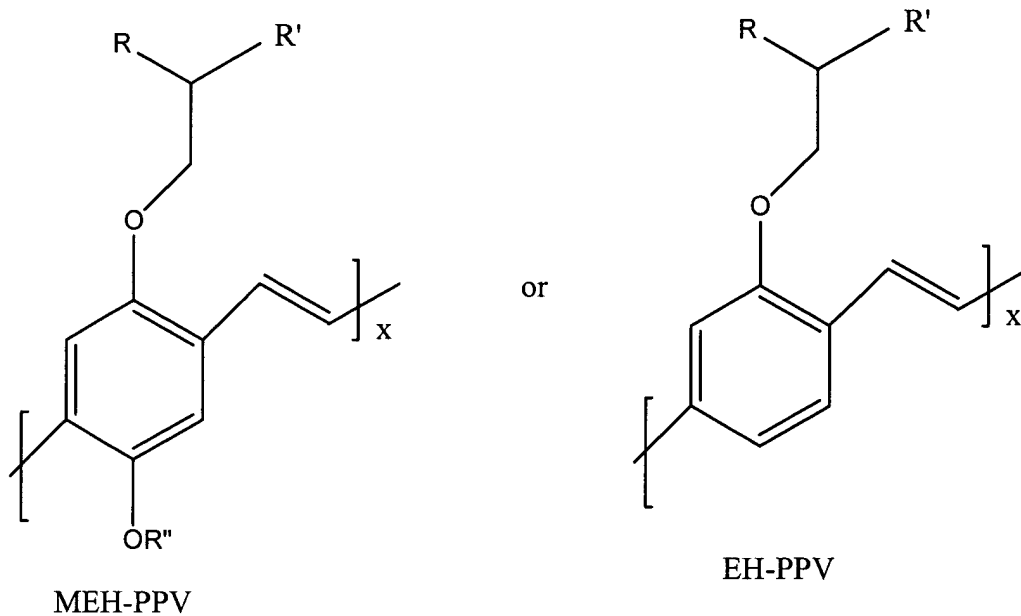
Applicant respectfully requests reconsideration in view of the amendment and following remarks. The applicant has incorporated the features of claim 22 into claim 21. The applicants have rewritten claim 23 as newly added claim 33. The applicant has inserted commas “,” between each of the formulas and has inserted the word “and” at the end of each group of formulas. The applicant has rewritten claim 24 as newly added claim 34. The applicant has added commas “,” between each of the formulas and has inserted the word “and” at the end of each group of the formulas and corrected one bond line in the second formula in the definition formula (IIIe). The applicant has incorporated the features of claim 28 into claim 27. The applicant has amended claim 29 by inserting commas “,” between each of the formulas and has inserted the word “or” at the end of each group of the formulas. The applicant has rewritten claim 30 as newly added claim 35. The applicant has added commas “,” between each of the formulas and have inserted the word “and” at the end of each group of the formulas and corrected one bond line in the second formula in the definition formula (IIIe).

There is no additional search required for this amendment. Claim 21 is the previously submitted claim 22 rewritten in the independent form. Claim 27 is the previously submitted claim 28 rewritten in the independent form. Claims 33-35 are claims 23, 24 and 30 rewritten in proper format with commas separating each of the groups and a connecting word added before the last group.

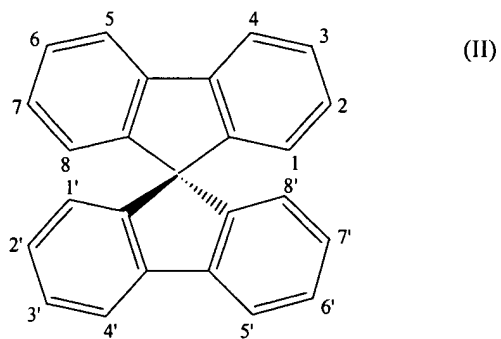
Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moses U.S. Patent No. 5,237,582 ("the '582 patent") in view of Lupo *et al.* European Patent No. 0676461A2 ("the '461 patent"). The applicant again respectfully traverses this rejection.

### 35 U.S.C. §103 Rejection

Claims 21-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moses in view of Lupo. The Examiner correctly stated that Moses lacks the spiro dye of formula (1). However, Moses teaches a specific dye of having the following chemical formulas:



These formulas are not remotely related to the applicants' claimed spiro dye of the formula (II).



There is no suggestion or teaching in Moses to use any other dye then the two dyes described above.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

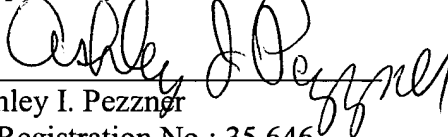
Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the

prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Moses and Lupo.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09931-00009-USA from which the undersigned is authorized to draw.

Respectfully submitted,

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